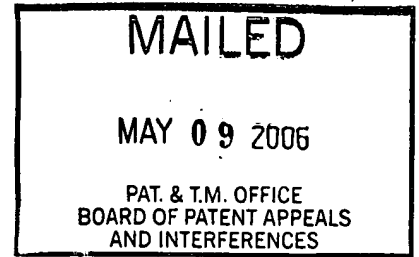


UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---



Ex parte PETER NASH, JOHN W. ROSEVEAR and DONALD L. ROBINSON

---

Application No. 10/038,260

---

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

---

This application was electronically received at the Board of Patent Appeals and Interferences on April 13, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

A review of the file indicates that the appeal brief filed September 23, 2004 and the examiner's answer mailed December 12, 2004 have used the format set forth in 37 CFR § 1.192(c). However, 37 CFR § 1.192 was abolished on September 13, 2004, and

replaced by 37 CFR § 41.37(c). Accordingly, the appeal brief filed on September 23, 2004 and the examiner's answer mailed December 17, 2004 does not comply with 37 CFR § 41.37(c).

37 CFR § 41.37(c) states:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(I) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(I) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

(vi) *Grounds of rejection to be reviewed on appeal.* A concise statement of each ground of rejection presented for review.

(vii) *Argument.* Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group.

(ix) *Evidence appendix.* An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131,

or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix*. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

A review of the application indicates that the following appropriate sections are missing from the appeal brief filed September 23, 2004 and the examiner's answer mailed December 17, 2004:

- 1) "Summary of claimed subject matter" as set forth in 37 CFR § 41.37(c)(1)(v);
- 2) "Grounds of rejection to be reviewed on appeal" as set forth in 37 CFR § 41.37(c)(1)(vi);
- 3) "Argument" as set forth in 37 CFR § 41.37(c)(1)(vii);
- 4) "Evidence appendix" as set forth in 37 CFR § 41.37(c)(1)(ix); and
- 5) "Related proceedings appendix" as set forth in 37 CFR § 41.37(c)(1)(x).

A substitute appeal brief and a revised examiner's answer that is in compliance with 37 CFR § 41.37 are required. For more

Application No. 10/038,260

information on the Board's new rules see the web page entitled  
More Information on the Rules of Practice Before the BPAI, Final  
Rule at:

[http://www.uspto.gov/web/offices/dcom/bpai/fr2004/  
moreinfo.html](http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html).

Accordingly, it is

**ORDERED** that this application be returned to the  
examiner to: 1) hold the appeal brief of September 23, 2004  
defective; 2) request appellants to file a substitute appeal  
brief in compliance with 37 CFR § 41.37; 3) vacate the examiner's  
answer and provide a revised examiner's answer in accordance with  
the new rules effective September 13, 2004 in response to the  
substitute appeal brief; and 4) for such further action as may be  
appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

By: 

Dale M. Shaw  
Deputy Chief Appeal Administrator  
(571) 272-9797

cc: RICHARD JOHN BARTZ  
SOUTHDALE OFFICE CENTRE, SUITE 350  
6750 FRANCE AVENUE SOUTH  
EDINA, MN 55435

DMS/lbg